



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097393,616	09/10/99	OLAFFSON	S 98RSS303

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WM02/1107

EXAMINER

ENG, G

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 11/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/393,616

Applicant(s)

OLAFFSON ET AL.

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7-10,19,20,32,33,40-42,44,45,47,48,54-56,63-65 and 68-84 is/are pending in the application.
- 4a) Of the above claim(s) 47 and 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7-10,19,20,32,33,40-42,44,45,54-56,63-65 and 68-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. This Office action is in response to the amendment filed 8/24/2001 (paper no. 14).

Claim Objections

2. Claims 47-48 are objected to as being in improper form because claims 47-48 are depending on canceled claim 46. Accordingly, the claims 47-48 have not been further treated on the merits.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 7, 10, 19-20, 32-33, 40-42, 44-45, 54-56, 63-66, 68, 70-77 and 79-83 are rejected under 35 U.S.C. 102(b) as being anticipated by Civanlar et al. (EP 0741481 A2 hereinafter Civanlar).

Regarding claim 1, Civanlar discloses a communication system having a telephone network (116) that delivers call waiting signaling upon detect an incoming call (col. 4 lines 31-32). The communication system comprises a remote modem (104) having a hold mode and a

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local modem (102) communicatively coupled to the remote modem via shared access to the telephone network (figure 1, abstract and col. 4 lines 10-24). In addition, the local modem directs the remote modem to enter the hold mode then temporarily relinquished to the telephone network after detecting the call waiting signaling (col. 2 lines 27-55 and col. 4 lines 34-44). Furthermore, Civanlar teaches the remote modem remaining in the hold mode for no longer than a predetermined interval, wherein the predetermined interval is communicated by the local modem to the remote modem (col. 9 lines 28-43 and col. 10 lines 11-19).

Regarding claim 7, Regarding claim 1, Civanlar discloses a communication system having a telephone network (116) that delivers call waiting signaling upon detect an incoming call (col. 4 lines 31-32). The communication system comprises a remote modem (104) having a hold mode and a local modem (102) communicatively coupled to the remote modem via shared access to the telephone network (figure 1, abstract and col. 4 lines 10-24). In addition, the local modem directs the remote modem to enter the hold mode then temporarily relinquished to the telephone network after detecting the call waiting signaling (col. 2 lines 27-55 and col. 4 lines 34-44). Furthermore, Civanlar teaches the local modem using V.42 standard protocol to set up a secondary channel for signaling the remote modem regarding the hold mode (col. 9 line 57 through col. 10 line 1).

Regarding claim 10, Civanlar teaches to maintain a network connection by communicating with upper layers while in the hold mode (col. 7 lines 21-36).

Regarding claim 19, Civanlar discloses a modem (102) coupled to a computing system via a telephone line to a telephone network (116), wherein the modem comprises a processing circuit having a first mode in which communication is exchanged in an established data session

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and a second mode in which the established data session is temporarily placed on hold, and the processing circuit entering the second mode in response to signals received via the telephone network and interacting with a protocol stack as if the processing circuit was operating in the first mode (col. 2 lines 27-55 and col. 6 line 8 through col. 8 line 12).

Regarding claim 20, Civanlar clearly discloses the data session comprising communication on a primary channel, wherein the signal received via the telephone network are received on a secondary channel (figure 1).

Regarding claim 32, Civanlar discloses a communication device (102) for communication with a remote device (104) over a communication channel, wherein the communication device obviously comprises a receiver for receiving attention signal to indicate whether to accept or reject a call, a decoder for decoding the attention signal, and a transmitter for transmitting a hold request to the remote device in response to the attention signal, wherein the communication over said channel ceases for a period of time after transmitting the hold request (col. 7 line 1 through col. 8 line 12). In addition, Civanlar teaches to generate the attention signal as user indicates to accept the call, i.e., off hook a handset (col. 7 lines 16-20 and 7 lines 55-58).

Regarding claim 33, Civanlar teaches the hold request including the period of time (col. 9 lines 31-37).

Regarding claim 40, Civanlar teaches the communication device keeping an upper layer protocol alive during said period of time, i.e. during hold period (col. 7 lines 29-31).

Regarding claim 41, Civanlar discloses to retransmit the hold request using a secondary channel (col. 7 lines 21-24).

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Regarding claim 42, Civanlar discloses said communication device receiving an acknowledgement in response to the hold request (col. 7 lines 24-27).

Regarding claim 44, the limitations of the claim are rejected as the same reasons set forth in claim 32.

Regarding claim 45, the limitations of the claim are rejected as the same reasons set forth in claim 33.

Regarding claim 54, the limitations of the claim are rejected as the same reasons set forth in claim 40.

Regarding claim 55, the limitations of the claim are rejected as the same reasons set forth in claim 41.

Regarding claim 56, the limitations of the claim are rejected as the same reasons set forth in claim 42.

Regarding claim 63, Civanlar discloses a routing method for use in a communication system including a first communication device (102), a second communication device (104), and a third communication device (115), wherein the first communication device and the second communication device are in communication over a communication line (col. 6 lines 10-13), the routing method comprising the steps of requesting said communication to be placed on hold (col. 6 lines 33-40), receiving an acknowledgement from said first device that said communication has been placed on hold for a period of time (col. 7 lines 21-36 and col. 9 lines 20-37), switching the communication line from the first device to the third device (col. 7 line 36 through col. 8 line 12), and resuming the communication after expiration of the period of time (col. 9 lines 38-56).

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Regarding claim 64, Civanlar teaches to transmit an attention signal, i.e., a call waiting alert tone, to said first device (col.6 lines 33-40).

Regarding claim 65, Civanlar teaches to transmit an attention signal, i.e., a hold request signal, to the second device (col. 7 lines 21-36).

Regarding claims 66 and 71, the limitations of the claim are rejected as the same reasons set forth in claim 44. Note while Civanlar does not specifically teaching to keep an upper layer protocol alive by the first communication device during said hold period. However, Civanlar teaches to maintain communication between the first communication device and the second communication device as the first communication is engaging with a call waiting call (col. 7 lines 29-36) which inherently comprises to keep said upper layer protocol alive.

Regarding claim 68, the limitations of the claim are rejected as the same reasons set forth in claim 41.

Regarding claim 70, Civanlar teaches to provide a new communication channel for connecting telephone device A and telephone device C (col. 8 lines 10-12) so that a dial tone is inherently provided to the telephone devices as data communication ceases.

Regarding claim 72, Civanlar teaches to hold the communication for a predetermined interval (col. 9 lines 28-37 and col. 10 lines 11-19) so that the hold request is containing the hold period.

Regarding claim 73, Civanlar discloses a communication system having a telephone network (116) that delivers call waiting signaling upon detect an incoming call (col. 4 lines 31-32). The communication system comprises a remote modem (104) having a hold mode and a local modem (102) communicatively coupled to the remote modem via shared access to the

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telephone network (figure 1, abstract and col. 4 lines 10-24). In addition, the local modem directs the remote modem to enter the hold mode then temporarily relinquished to the telephone network after detecting the call waiting signaling (col. 2 lines 27-55 and col. 4 lines 34-44). In addition, Civanlar teaches to provide a new communication channel for connecting telephone device A and telephone device C (col. 8 lines 10-12) so that a dial tone is inherently provided to the telephone devices as data communication ceases.

Regarding claims 74-77, Civanlar teaches the relinquishment request is received from a third device, or the handset going off-hook (col. 6 lines 31-33 and col. 7 lines 36-47).

Regarding claims 79-80, the limitations of the claim are rejected as the same reasons set forth in claim 73.

Regarding claims 81-83, the limitations of the claim are rejected as the same reasons set forth in claims 74-77.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Civanlar et al. (EP 0741481 A2 hereinafter Civanlar) in view of Hamasaki (US PAT. 5,131,025).

Regarding claims 8-9, Civanlar differs from the claimed invention in not specifically teaching a table storing pre-select caller identification information for comparison with the call identification information of incoming calls to determine whether to service incoming call. However, Hamasaki teaches an intelligent modem comprising means for storing identification information and means for comparing the stored identification information with the call identification information of incoming calls to determine whether to service incoming call (col. 9 lines 53-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Civanlar in having storing means and comparing means because prevents the operation of modem communication from being disrupted by unauthorized parties.

7. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Civanlar et al. (EP 0741481 A2 hereinafter Civanlar).

Regarding claim 69, Civanlar differs from the claimed invention in not specifically teaching the local modem to communicate a second time period to the remote modem to extend the hold mode. However, Civanlar teaches to maintain the hold mode until the call waiting call

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completed (col. 7 line 13-30). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Civanlar in communicating the second time period to the remote modem to extend the hold mode in order to prevent disconnection between the local modem and the remote modem.

8. Claims 78 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Civanlar et al. (EP 0741481 A2 hereinafter Civanlar) in view of Ko (US PAT. 5,684,825).

Regarding claim 78, Civanlar differs from the claimed invention in not specifically teaching to provide a three-way calling feature. However, Ko teaches to use a SVD modem for providing three-way calling feature (col. 1 lines 47-61). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Civanlar in providing a three-way calling feature, as per teaching of Ko, because it makes user friendly so that it allows a central office to service voice and data calls with different party over a same telephone line.

Regarding claim 84, the limitations of the claim are rejected as the same reasons set forth in claim 78.

Response to Arguments

9. Applicant's arguments filed 8/24/2001 (paper no. 14) have been fully considered but they are not persuasive.

In response to applicant's argument of claim 1 that Civanlar does not teach the local modem communicating to the remote modem the hold period. However, it appears that Civanlar

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clearly discloses the hold period is communicated by the local modem to the remote modem (col. 9 lines 28-43 and col. 10 lines 11-19). Note while the claimed language does not clearly define how to communicate the hold period between the local modem and the remote modem. Thus, such broad claim language can be rejected by Civanlar.

In response to applicant's argument of claim 7 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., v.42 error correction protocol for signaling the remote modem regarding the hold mode) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument of claims 19-20 that Civanlar does not disclose higher protocol layers in a network environment. However, it appears that Civanlar teaches to maintain communication between the first communication device and the second communication device as the first communication is engaging with a call waiting call (col. 7 lines 29-36) which inherently comprises to interact with protocol stack in order to prevent time out condition in a data session. Note while the claimed limitations do not clearly define the environment as described in the specification. Thus, it can be still rejected by Civanlar.

In response to applicant's argument of claims 32-35 and 38-42 that Civanlar fails to disclose hold request generated in response to the handset off-hold. However, Civanlar clearly teaches to generate the attention signal as user indicates to accept the call (col. 7 lines 16-20 and 7 lines 55-58). As the call accepted, the handset is off-hook and the data communication is ceased.

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In response to applicant's argument of claims 63-65 that Civanlar fails to teach to switch the communication line from the first device to the third device. However, it appears that Civanlar clearly teaches to switch the communication line from the first device to the third device (col. 7 line 36 through col. 8 line 12). Thus, the rejection is maintained.

In response to applicant's argument of claims 66-68 that Civanlar fails to teach keeping the upper layer protocol alive by the second device during the hold period. However, Civanlar teaches to maintain communication between the first communication device and the second communication device as the first communication is engaging with a call waiting call (col. 7 lines 29-36) which inherently comprises to keep said upper layer protocol alive. Thus, the rejection is maintained.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 308-6306, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

(703) 308-6296 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA, Sixth Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to George Eng whose telephone number is (703) 308-9555. The
examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Group receptionist whose telephone number is (703) 305-3900.



**DUC NGUYEN
PRIMARY EXAMINER**

GEORGE ENG
PATENT EXAMINER
ART UNIT 2643